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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Peter K. Kassab

Application No. 09/901,472

Confirmation No. 6545

Filed July 9, 2001

For: Vinyl Film Intermediary

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) Examiner: Steven D. Maki
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) Art Unit: 1733
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APPELLANT'S AMENDED APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Appellant submits this Amended Appeal Brief, in triplicate, in furtherance of the Notification of Non-Compliant Appeal Brief dated February 16, 2006.

TABLE OF CONTENTS

<u>Section</u>	<u>Page</u>
I. REAL PARTY IN INTEREST	5
II. RELATED APPEALS AND INTERFERENCES	5
III. STATUS OF CLAIMS	5
IV. STATUS OF AMENDMENTS	5
V. SUMMARY OF THE CLAIMED SUBJECT MATTER	6
A. Claim 1	6
B. Claim 2	7
C. Claim 6	7
D. Claim 11	8
E. Claim 13	8
F. Claim 14	10
G. Claim 22	11
H. Claim 23	11
I. Claim 24	12
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	13
VII. ARGUMENTS	13
A. Claim 23 Meets the Requirements of Section 112	13
B. German '696 and Courtney and Japan '014 and at Least One of the Admitted Prior Art (Specification pgs. 1-3, page 18, lines 12-17), Great Britain '233 and Langen and Do Not Render Claims 1, 2, 4, 5, 6, 11, 13, 14, 22, and 24 Obvious	14
1. The Standard of Law for a Section 103 Rejection	14
2. No Suggestion or Motivation to Combine	15
a. Claim 1	18

b. Claim 2.....	24
c. Claim 4.....	24
d. Claim 5.....	24
e. Claim 6.....	24
f. Claim 11	24
g. Claim 13.....	25
h. Claim 14.....	25
i. Claim 22.....	25
j. Claim 23.....	25
k. Claim 24.....	26
3. German '696, Courtney, Japan '014 and at Least One of the Admitted Prior Art (Specification pgs. 1-3, pg. 18, lns. 12-17), Great Britain '233 and Langen Do Not Suggest All Limitations of Claims 6, 11, 13, 14, 22 and 24.....	26
a. Claim 6.....	27
b. Claim 11	28
c. Claim 13	28
d. Claim 14.....	31
e. Claim 22	31
f. Claim 24	31
C. Langen and Honaker or Yoshida Do Not Render Claims 1, 14, and 22 Obvious.	32
1. There is No Suggestion or Motivation to Combine Langen and Honaker or Yoshida.....	32
2. Langen and Honaker or Yoshida Do Not Suggest All Limitations of Claims 1, 14, and 22	32
a. Claim 1	32
b. Claim 14.....	33
c. Claim 22	34
D. German '696 and Japan '014 and Either Great Britain '233 or Langen Do Not Render Claim 23 Obvious.....	34
1. There is No Suggestion or Motivation to Combine.....	35

2. German '696 and Japan '014 and at Least One of Great Britain '233 and Langen Do Not Suggest All Limitations of Claim 23	36
E. Appellant's Invention Has Been Well-Received in the Marketplace	36
VIII. CONCLUSION	38
CLAIMS APPENDIX	
EVIDENCE APPENDIX	
RELATED PROCEEDINGS APPENDIX	

I. REAL PARTY IN INTEREST

The real party in interest is Peter K. Kassab, the individual inventor, to whom all right, and interest in this patent application belong to (hereinafter referred to as "Appellant").

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Twenty-four (24) claims have been filed in the application. As of the Notice of Appeal, claims 1, 2, 4-6, 11, 13, 14, 16, and 22-24 were pending. Claim 16 has been allowed. Accordingly, claims 1, 2, 4-6, 11, 13, 14, and 22-24 are pending for appeal. A detailed status of the claims is as follows:

- A. Claims originally filed: 1-21
- B. Claims canceled: 3, 7-10, 12, 15, 17-21
- C. Claims added: 22-24
- D. Claims currently pending: 1, 2, 4-6, 11, 13, 14, 16, and 22-24
- E. Claims allowed: 16
- F. Claims rejected: 1, 2, 4-6, 11, 13, 14, and 22-24
- G. Claims objected to: None
- H. Claims on appeal: 1, 2, 4-6, 11, 13, 14, and 22-24

Each of the claims involved in this Appeal (1, 2, 4-6, 11, 13, 14, and 22-24) are included in the attached Appendix.

IV. STATUS OF AMENDMENTS

Prior to the Final Office Action, claims 1, 2, 4-6, 11, 13, 14, and 22-24 were pending in the application. In the Final Office Action, the Examiner rejected the pending claims 1, 2, 4-6, 11, 13, 14, and 22-24. A Notice of Appeal was timely filed on August 3, 2005. Therefore, claims 1, 2, 4-6, 11, 13, 14, and 22-24 are pending on appeal. A postcard mailed on August 5, 2005 acknowledged the Notice of Appeal filed by Appellant.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Peter K. Kassab is an individual inventor and sole inventor of the present application. Mr. Kassab conceived and reduced to practice his invention after experiencing difficulties using various types of windshield stickers on his car. (*See*, Declaration of Peter K. Kassab, Paragraph 2). Mr. Kassab has worked diligently in protecting and marketing his invention, and his product embodying his invention has been well-received in the marketplace. Mr. Kassab's product sales have continued to increase year after year. Thus, Mr. Kassab's product, that embodies his invention, has been successful and widely accepted by consumers. The claims embodying Mr. Kassab's invention are discussed in greater detail below.

Appellant's invention as claimed is directed to a sticker assembly utilizing a sticker and a vinyl film having a low-tack adhesive layer to form the sticker assembly. The vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing the peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker. In certain embodiments of the invention, a protective layer, or liner, is positioned over the low-tack adhesive layer. The protective layer is also trimmed and then removed when preparing to place the sticker assembly. With the low-tack adhesive, the sticker assembly can be easily peeled off and repositioned on the receiving surface or windshield over and over again. In addition, the receiving surface or windshield is not damaged by the low-tack adhesive or the removal process.

A. Claim 1

As shown in FIGS. 16-17 and 3-8, as well as generally described on page 22, ln. 3 to page 26, ln. 20 of the Application, the present invention relates to a sticker assembly 110 comprising a sticker 30 having an indicia-bearing surface 32 and peripheral edges 38. The vinyl film 100 comprises a non-perforated layer of vinyl film 100 having a first side 102, a second side 104, and outer edges. The second side 104 has a low-tack adhesive layer 106 (Spec. pg. 22, ln. 3-23). An adhesive 34 is disposed between the sticker 30 and the first side 102 of the film 100. This results in direct contact of the adhesive 34 with the vinyl film 100 and fixedly attaches the sticker 30 to the vinyl film 100. The indicia-bearing surface 32 of the sticker 30 is viewable through a receiving surface (Spec. pg. 23, ln. 8-27). The vinyl film 100 is trimmed (FIG. 6) to

define peripheral edges 38 of the vinyl film 100, placing the peripheral edges 38 of the vinyl film 100 essentially in registry with peripheral edges 38 of the sticker (Spec. pg. 23, ln. 27 - pg. 24, ln. 12). The second side 104 of the vinyl film 100 is adapted be releasably adhered to a receiving surface (Spec. pg. 24, ln. 13 - pg. 25, ln. 9; FIG. 17). Similar reference numerals are applicable to similar claim elements recited in the other independent claims listed below.

B. Claim 2

The invention also relates to a method of releasably adhering a vehicle windshield sticker 30 to a vehicle windshield 12. The method comprises providing an indicia-bearing windshield sticker 30 having an adhesive layer 34. It also comprises providing a continuous, uninterrupted layer of vinyl film 100 having a first side 102 and a second side 104. The second side 104 has a low-tack adhesive 106 (Spec. pg. 22, ln. 3-23). The sticker 30 is adhered to the first side 102 of the vinyl film 100 via the adhesive layer 34. The adhesive layer 34 is in direct contact with the first side 102 of the film 100. The adhesive layer 34 fixedly attaches the sticker 30 to the first side 102 of the film 100. The vinyl film 100 is trimmed to place the peripheral edges 38 of the vinyl film 100 in registry with peripheral edges 38 of the windshield sticker 30 to form a sticker assembly 110 (Spec. pg. 23, ln. 28 - pg. 24, ln. 12.) The sticker assembly 110 is adhered to the windshield 12 by placing the second side 104 of the vinyl film 100 against the windshield 12. (FIG. 17.) The low-tack adhesive 106 releasably adheres to the windshield 12 and the indicia is viewable through the windshield 12 (Spec. pg. 24, ln. 13 - pg. 25, ln. 9; FIG. 17). The sticker assembly 110 can be peeled off the windshield 12 without damage to the sticker 30. *Id.*

C. Claim 6

In another embodiment, the invention relates to a sticker assembly 110 for a vehicle. The sticker assembly 110 comprises an indicia-bearing window sticker 30 having an adhesive layer 34. There is a continuous, uninterrupted layer of optically clear vinyl film 100 having a first side 102 and a second side 104 (Spec. pg. 22, ln. 3-23). The second side 104 has a low-tack adhesive 106 and a protective layer 108 positioned over the low-tack adhesive 106 (Spec. pg. 22, ln. 3-23; FIG. 16). The first side 102 is adhered directly to the adhesive layer 34 of the window sticker 30. The adhesive layer 34 fixedly attaches the window sticker 30 to the first side 102 of the

vinyl film 100. The vinyl film 100 and protective layer 108 are trimmed (FIG. 6) so that peripheral edges 38 of the vinyl film 100 and protective layer 108 are essentially in registry with peripheral edges 38 of the window sticker 30 (Spec. pg. 23, ln. 28, pg. 24, ln. 2). Upon removal of the trimmed protective layer, the low-tack adhesive 106 on the second side 104 of the vinyl film 100 is releasably adhereable to the window (Spec. pg. 24, ln. 10-12). The indicia-bearing sticker 30 is viewable through the window from outside of the vehicle. (FIG. 17.) The vinyl film 100 is undetectable when viewed through the window from outside of the vehicle (Spec. pg. 24, ln. 13 - pg. 25, ln. 9; FIG. 17).

D. Claim 11

In another embodiment, the invention relates to a method of releasably adhering a vehicle windshield sticker 30 to a vehicle windshield 12. An indicia-bearing windshield sticker 30 having an adhesive layer 34 and a non-perforated layer of vinyl film 100 are provided. The non-perforated layer of vinyl film 100 has a first side 102 and a second side 104 (Spec. 22, ln. 3-23). The second side 104 has a low-tack adhesive 106 thereon and a protective layer 108 positioned over the low tack adhesive (Spec. pg. 22, ln. 3-23). The first side 102 of the film 100 is positioned over the adhesive on the sticker 30 and adheres the first side 102 of the film 100 directly to the adhesive. The vinyl film 100 cannot be separated from the adhesive without destroying the vinyl film 100 and the sticker 30. The vinyl film 100 and protective layer 108 are trimmed (FIG. 6). This places the vinyl film 100 and protective layer 108 in registry with peripheral edges 38 of the windshield sticker 30 (Spec. pg. 23, ln. 27 - pg. 24, ln. 12). Upon removal of the trimmed protective layer, the sticker assembly 110 is releasably adhered to the windshield 12. The low-tack adhesive 106 on the second side 104 of the vinyl film 100 is positioned against the windshield 12 (Spec. pg. 24, ln. 13 - pg. 25, ln. 9; FIG. 17). The indicia is viewable through the windshield 12. *Id.* The sticker assembly 110 can be peeled off the windshield 12 without damage to the sticker 30. *Id.*

E. Claim 13

In another embodiment, the invention relates to a method of releasably adhering a vehicle windshield sticker 30 to a vehicle windshield 12. An indicia-bearing windshield sticker 30

having an adhesive layer 34 is provided. The adhesive layer 34 comprises a first strip of adhesive positioned along a peripheral edge of the sticker 30. A second strip of adhesive is positioned along an opposite peripheral edge of the sticker 30 (Spec. pg. 18, ln. 12-24; FIGS. 15-17). An indicia bearing portion of the sticker does not have an adhesive over that portion. Also provided is a first non-perforated strip of vinyl film 100. The vinyl film 100 has a first side 102 and a second side 104, the second side 104 having a low-tack adhesive 106. (See Spec. pg. 22 ln. 3-23.) The method further includes trimming the first strip of vinyl film 100 to correspond in size to the first strip of adhesive on the sticker 30. *Id.* A second non-perforated strip of vinyl film 100 is provided. The vinyl film 100 has a first side 102 and a second side 104 (Spec. pg. 18, ln. 12-24; FIGS. 15-17). The second side 104 of the second strip of film 100 has a low-tack adhesive 106 (Spec. pg. 22, ln. 3-23). The method further includes trimming the second strip of vinyl film 100 to correspond in size to the second strip of adhesive on the sticker 30 (Spec. pg. 18, ln. 11-24; FIG. 6). The first side 102 of the first strip of film 100 is then positioned to correspond to the first strip of adhesive (Spec. pg. 18, ln. 11-24; FIG. 15). The first side 102 of the first strip of film 100 is adhered directly to the first strip of adhesive so that the first strip of film 100 cannot be separated from the first strip of adhesive without destroying the first strip of film 100 and the sticker 30. *Id.* The first side 102 of the second strip of film 100 is positioned to correspond to the second strip of adhesive. *Id.* The first side 102 of the second strip of film 100 is directly adhered to the second strip of adhesive so that second strip of film 100 cannot be separated from the second strip of adhesive without destroying the second strip of film 100 and the sticker 30. *Id.*

The sticker 30, the first and second strips of adhesive and the first and second strips of vinyl film 100 defining a sticker assembly 110, is releasably adhered to the windshield 12. *Id.* The second side 104 s of the strips of vinyl film 100 are placed against the windshield 12. *Id.* The low-tack adhesive 106 on the second side 104 of the first strip of vinyl film 100 is positioned against the windshield 12 and the low-tack adhesive 106 on the second side 104 of the second strip of vinyl film 100 is positioned against the windshield 12. *Id.* The indicia is viewable

through the windshield 12 and the sticker assembly 110 can be peeled off the windshield 12 without damage to the sticker 30. *Id.*

F. Claim 14

In another embodiment, the invention relates to a sticker assembly 110 for a vehicle having a windshield 12. The assembly 110 comprises an indicia-bearing windshield sticker 30 having an indicia-bearing substrate 16 with an adhesive layer 34 disposed on the substrate 16. The adhesive layer 34 comprises a first strip of adhesive positioned along a peripheral edge of the sticker and a second strip of adhesive positioned along an opposite peripheral edge of the sticker 30 (Spec. pg. 18, ln. 12-24; FIGS. 15-17.) It further comprises a first non-perforated strip of vinyl film 100 having a first side 102 and a second side 104. The second side 104 of the first strip of film 100 has a low-tack adhesive 106 and a first protective layer 108 positioned over the low-tack adhesive 106. (See Spec. pg. 22, ln. 3-23.) The first strip of vinyl film 100 and first protective layer 108 are trimmed to correspond in size to the first strip of adhesive of the sticker 30 (Spec. pg. 18, ln. 11-24; FIGS. 6, 15-17.) Upon removal of the first protective layer, the first side 102 of the first strip of film 100 positioned to correspond to the first strip of adhesive. *Id.* It is adhered directly to the first strip of adhesive so that the first strip of film 100 cannot be separated from the first strip of adhesive without destroying the first strip of film 100 and the sticker 30. *Id.* It also comprises a second non-perforated strip of vinyl film 100 having a first side 102 and a second side 104 (Spec. pg. 18, ln. 12-24; FIGS. 15-17). The second side 104 of the second strip of film 100 has a low-tack adhesive 106 and a second protective layer 108 positioned over the low-tack adhesive 106. The second strip of vinyl film 100 and second protective layer 108 are trimmed to correspond in size to the second strip of adhesive of the sticker 30 (Spec. pg. 18, ln. 11-24; FIGS. 6, 15-17.) Upon removal of the second protective layer, the first side 102 of the second strip of film 100 is positioned to correspond to the second strip of adhesive and is adhered directly to the second strip of adhesive so that the second strip of film 100 cannot be separated from the second strip of adhesive without destroying the second strip of film 100 and the sticker 30. *Id.* The second sides 104 of the strips of vinyl film 100 are capable of being releasably adhered to the windshield 12 so that the indicia-bearing substrate 16

is viewable through the windshield 12 from outside of the vehicle. The indicia bearing portion of the sticker 30 does not have adhesive over that portion, and the strips are trimmed to correspond in size to the strips of adhesive. *Id.* The strips are undetectable when viewed through the windshield 12 from outside of the vehicle. *Id.*

G. Claim 22

In another embodiment, the invention relates to a sticker assembly 110 for a vehicle having a windshield 12. The assembly 110 comprises an indicia-bearing windshield sticker 30 having an indicia-bearing substrate 16 with an adhesive layer 34 disposed on the substrate 16. The adhesive layer 34 comprises a first strip of adhesive positioned on the substrate 16 and a second strip of adhesive positioned on the substrate 16 (Spec. pg. 18, ln. 12-24; FIGS. 15-17). A first non-perforated strip of vinyl film 100 has a first side 102 and a second side 104. The second side 104 of the first strip of film 100 has a low-tack adhesive 106. (See Spec. p. 22, ln. 3-23). The first side 102 of the first strip of film 100 is positioned to correspond to the first strip of adhesive and is adhered directly to the first strip of adhesive so that the first strip of film 100 cannot be separated from the first strip of adhesive without destroying the first strip of film 100 and the sticker 30. *Id.* A second non-perforated strip of vinyl film 100 has a first side 102 and a second side 104. *Id.* The second side 104 of the second strip of film 100 has a low-tack adhesive 106. The first side 102 of the second strip of film 100 is positioned to correspond to the second strip of adhesive and is adhered directly to the second strip of adhesive so that the second strip of film 100 cannot be separated from the second strip of adhesive without destroying the second strip of film 100 and the sticker 30 (Spec. pg. 18, ln. 11-24; FIGS. 6, 15-17). The second side 104 s of the strips of vinyl film 100 are capable of being releasably adhered to the windshield so that the indicia-bearing substrate is viewable through the windshield 12 from outside of the vehicle, and the strips are trimmed to correspond in size to the strips of adhesive. *Id.*

H. Claim 23

In another embodiment, the invention relates to an intermediary for a window sticker 30 for a vehicle having a window. The sticker 30 is an indicia-bearing window sticker with an

adhesive layer 34. The intermediary comprises a continuous, uninterrupted layer of optically clear vinyl film 100 having a first side 102 and a second side 104. The second side 104 has a low-tack adhesive 106 and a protective layer 108 positioned over the low-tack adhesive 106 (Spec. pg. 22, ln. 3-23). The first side 102 is adapted to be adhered directly to the adhesive layer 34 of the window sticker 30. The adhesive layer 34 is adapted to fixedly attach the window sticker 30 to the first side 102 of the vinyl film 100. The vinyl film 100 and protective layer 108 are trimmed such that peripheral edges 38 of the vinyl film 100 and protective layer 108 are essentially in registry with peripheral edges 38 of the window sticker 30 (Spec. pg. 18, ln. 11-24; FIG. 6). Upon removal of the trimmed protective layer, the low-tack adhesive 106 on the second side 104 of the vinyl film 100 is releasably adhereable to the window (Spec. pg. 24, ln. 13 - pg. 25, ln. 9; FIG. 17). The indicia-bearing sticker is viewable through the window from outside of the vehicle and the vinyl film 100 is undetectable when viewed through the window from outside of the vehicle. *Id.*

I. Claim 24

In another embodiment, the invention relates to a sticker assembly for a vehicle having a windshield 12. The assembly comprises an indicia-bearing windshield sticker 30 having an indicia-bearing substrate with an adhesive layer 34 disposed on the substrate. The adhesive layer 34 comprises a strip of adhesive positioned along a peripheral edge of the sticker 30 (Spec. pg. 18, ln. 12-24; FIGS. 15-17). The assembly also comprises a non-perforated strip of vinyl film 100 with a first side 102 and a second side 104. *Id.* The second side 104 of the strip of film 100 has a low-tack adhesive 106. (See Spec. pg. 22, ln. 3-23.) The first side 102 of the strip of film 100 is positioned to correspond to the strip of adhesive and is adhered directly to the strip of adhesive so that the strip of film 100 cannot be separated from the strip of adhesive without destroying the strip of film 100 and the sticker 30 (Spec. pg. 18, ln. 12-24; FIGS. 15-17). The second side 104 of the strip of vinyl film 100 is capable of being releasably adhered to the windshield 12 so that the indicia-bearing substrate is viewable through the windshield 12 from outside of the vehicle. The strip is trimmed to correspond in size to the strip of adhesive, and the strip is undetectable when viewable through the windshield 12 from outside of the vehicle. *Id.*

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection should be reviewed on appeal:

1. Whether claim 23 was properly rejected under 35 U.S.C. 112 as being indefinite.
2. Whether claims 1, 2, 4, 5, 6, 11, 13, 14, 22, 23, and 24 were properly rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Courtney (US 5,622,389) and Japan '014 (JP 9-97014) and optionally further in view of at least one of the admitted prior art, Great Britain '233 (GB 2174233) and Langen (US 5,290,067).
3. Whether claims 1, 14, and 22 were properly rejected under 35 U.S.C. 103(a) as unpatentable over Langen in view of Honaker (4,935,288) or Yoshida et al.
4. Whether claim 23 was properly rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Japan '014 (JP 9-97014) and further in view of at least one of Great Britain '233 (GB 2174233) and Langen (US 5,290,067).

VII. ARGUMENTS

A. Claim 23 Meets the Requirements of Section 112

In the Final Office Action, the Examiner rejected independent claim 23 under 35 U.S.C. §112, second paragraph, as not distinctly claiming the subject matter of the invention. The Examiner concludes that the language regarding trimming suggests that the sticker assembly is being claimed and, therefore, considers claim 23 ambiguous. Appellant respectfully disagrees.

Claim 23 is directed to an intermediary for use in a sticker assembly for a car window. Claim 23 requires, among other things, "a continuous, uninterrupted layer of optically clear vinyl film having a first side and a second side, the second side having a low-tack adhesive thereon and a protective layer positioned over the low-tack adhesive, the first side adapted to be adhered directly to the adhesive layer of the window sticker wherein the adhesive layer is adapted to fixedly attach the window sticker to the first side of the vinyl film and wherein the vinyl film and protective layer are trimmed such that peripheral edges of the vinyl film and protective layer are adapted to be essentially in registry with peripheral edges of the window sticker."

Claim 23 specifies that the elements positively claimed, e.g., the vinyl film and the protective layer, are trimmed. These elements are trimmed such that peripheral edges of the vinyl film and the protective layer are adapted to be essentially in registry with peripheral edges of the window sticker. The sticker is not being positively claimed in claim 23 and the 'adapted to' language of claim 23 is, therefore, consistent with such position. Appellant submits that it is clear that only the vinyl film and protective layer are being claimed in claim 23 and that the sticker is not being claimed. Appellant submits that claim 23 meets the requirements of Section 112 and requests reversal of this rejection.

B. German '696 and Courtney and Japan '014 and at Least One of the Admitted Prior Art (Specification pgs. 1-3, page 18, lns. 12-17), Great Britain '233 and Langen Do Not Render Claims 1, 2, 4, 5, 6, 11, 13, 14, 22, 23, and 24 Obvious

In the Final Office Action, the Examiner rejected claims 1, 2, 4, 5, 6, 11, 13, 14, 22, 23, and 24 under 35 U.S.C. §103 as being unpatentable over German Patent No. DE 29720696 ("German '696") in view of U.S. Patent No. 5,622,389 to Courtney ("Courtney") and Japan Patent No. 9-97014 ("Japan '014") and further in view of at least one of the admitted prior art (Specification pgs. 1-3, page 18, lns. 12-17), Great Britain Patent No. 2174233 ("Great Britain '233") and U.S. Patent No. 5,290,067 to Langen ("Langen"). Appellant respectfully submits the Examiner has erred in maintaining this Section 103 rejection and respectfully requests reversal of this rejection.

1. The Standard of Law for a Section 103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest all of the claim limitations. The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. See MPEP §2142; *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

2. No Suggestion or Motivation to Combine

As an initial ground for overcoming the rejection, Appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness because there is no suggestion or motivation to combine the several different references as suggested by the Examiner. It respectfully appears to Appellant that the Examiner's position is based on hindsight reconstruction gained after review of Appellant's disclosure. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (finding it is impermissible to reconstruct the claimed invention from the prior art absent some suggestion or motivation in the prior art itself to do so).

Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal Inc.*, 231 F.3d 1339, 56 USPQ2d 1641, 1644 (Fed. Cir. 2000).

Appellant respectfully submits that the Examiner could only have arrived at a conclusion of obviousness through hindsight analysis by reading Appellant's own inventive teaching in the art and by attempting to select those elements from all of German '696, Courtney, Japan '014, the admitted prior art, Great Britain '233 or Langen, that he deemed relevant to the teachings of the present invention. Such decomposition of an invention "into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 U.S.P.Q.2d 1801, 1817 (N.D. Ill. 1993). The Federal Circuit has specifically noted:

[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious....[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

In addition, references that teach away cannot serve to create a *prima facie* case of obviousness. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001). A reference is said to "teach away" when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the appellant. *Tec Air, Inc. v. Denso Mfg. Mich., Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999). An appellant may refute obviousness if the appellant can show "that the art in any material respect taught away" from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir. 1997). Such a showing dissipates the *prima facie* holding and requires the examiner to "consider all of the evidence anew." *In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005).

Thus, unless the references suggest the particular combination of elements themselves, they cannot show the actual invention was obvious. *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 U.S.P.Q.2d 1801, 1817 (N.D. Ill. 1993). In other words, it is impermissible for the Examiner to pick and choose elements from German '696, Courtney, Japan '014, the admitted prior art, Great Britain '233 or Langen, to derive Appellant's invention. In addition, the Examiner may not ignore the other structural teachings of these references that teach away from making the Examiner's proposed combination.

In view of the forgoing, Appellant submits that it is error to combine the several different references to render the claimed invention obvious. The Examiner has merely cited to several different patents in an effort to piece together elements of the prior art to read on Appellant's claimed invention. While the Examiner attempts to give a reason why two of the patents, German '696 and Courtney, are combinable, the Examiner fails to point to a specific disclosure in the other references themselves that would give one the motivation to combine them. The

Examiner has used the present application as a template or blueprint to meet the several different claim limitations, which is an improper hindsight analysis expressly prohibited by the Federal Circuit. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 1596, 1600 (Fed. Cir. 1988). There is not the required disclosures in the reference themselves, to provide the requisite motivation to combine. To the contrary, the Examiner's primary reference expressly teaches away from the Examiner's proposed combination and thus, prevents the combination under the law. Appellant therefore submits that, because no *prima facie* case of obviousness has been established, the inventions of claims 1, 2, 4, 5, 6, 11, 13, 14, 22, and 24 are not obvious in view of the cited references.

Previously in the May 20, 2004 Office Action, the Examiner asserted two reasons as a motivation to combine German '696 and Courtney. First, the Examiner concluded that because German '696 taught to use a film as a releasable mounting aid for a sticker, German '696 therefore indicated that the film "should have a shape and size matching that of the sticker/the adhesive coating on the sticker." (See pg. 4 of May 20, 2005 Office Action.) Second, the Examiner concluded that obviousness was proper because "Courtney teaches adhering a sticker on a mounting sheet... and trimming the mounting sheet to match the shape and size of the sticker so that the mounting sheet is virtually undetectable..." *Id.* Based on Appellant's arguments in reply to the May 20, 2004 Office Action and the Examiner's statements in the Final Office Action of May 3, 2005, it is now clear that the Examiner has abandoned his first line of reasoning and now attempts to only rely on his second line of reasoning to support his motivation to combine position. (See pg. 7 of final Office action – "In short, the motivation for combining German '696 and Courtney is making a mounting aid undetectable to the casual viewer and reducing the potential for theft by appearance of permanent fixation. (emphasis in original)).

Thus, Appellant successfully rebutted the Examiner's first line of reasoning. The Examiner's first line of reasoning, however, was vital to the Examiner's obviousness conclusion because a suggestion that the film and sticker 'should have a matching size and shape' could be used as a basis to combine. Such a suggestion is not only completely absent in German '696, but the reference expressly teaches away from such a suggestion. Accordingly, the Examiner's

reliance on Courtney's "undetectable" suggestion is irrelevant to German '696 as German '696 leads one away from Courtney. Therefore, the abandonment of the Examiner's first line of reasoning exposes the flaw in the Examiner's obviousness position. Furthermore, Appellant submits that the same rebuttal arguments equally apply to the Examiner's second line of reasoning. German '696 expressly teaches away from the Examiner's proposed combination. In addition, the other references lack specific disclosures that provide a motivation to further combine with the other references. In sum, the Examiner merely selects patents in an attempt to piece the prior art together and ignores the express teaching away by German '696. Consequently, the references are not properly combinable. Without the requisite motivation, Appellant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1, 2, 4–6 and 11, 13, 14, 22 and 24. Appellant now discusses the proposed combination in detail.

a. Claim 1

As previously discussed, claim 1 requires, among other things, that "the vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker." (*See, e.g.,* FIGS. 6, 9 and 17 of Application.) The trimming element of the present invention provides several advantages. By trimming the vinyl film so the peripheral edges are essentially in registry, the vinyl film is virtually undetectable. Thus, only the owner of the sticker assembly knows of its presence. This helps to avoid theft of the sticker assembly. It also avoids unsightliness such as when the peripheral edges of the film extend beyond the sticker. This would surely happen in German '696 as there is absolutely no disclosure or suggestion for trimming. In addition, by trimming the vinyl film, more sticker assemblies can be placed on a windshield without overlapping. Also, the edges of the sticker acts as a guide for the trimming as shown in FIG. 6. With the edges of the film trimmed so that the film corresponds in size to the sticker, the sticker assembly can be placed closer to the edge of a windshield, thus minimizing potential blind spots and increasing the field of vision through the windshield. Finally, by trimming the edges of the vinyl film, a user can more easily carry the assembly without getting hand dirt and oils on the low-tack

adhesive, because the assembly is stiffer wherein the peripheral edges of the assembly can be positioned between the fingers and thumb of a user (similar to carrying a compact disk). If the peripheral edges of the film were not trimmed, these film-only edges, extending from the sticker, would fold over when a user attempted to hold the assembly between the fingers and thumb of the user.

The trimming element of claim 1 is not disclosed or suggested in any of the several different references initially cited by the Examiner. German '696 has a specification that is only eight sentences, and contains no drawing figures. German '696 lacks much specificity and is void of any disclosure or suggestion of trimming. Japan '014 is likewise void of any discussion of trimming. The admitted prior art also lacks any disclosure or suggestion of trimming. Great Britain '233 and Langen also do not disclose or suggest trimming a vinyl film as claimed. During prosecution, the Examiner subsequently cited Courtney as disclosing the trimming element. Courtney is directed to a bumper device and method wherein a bumper sticker is mounted to a mounting sheet. The mounting sheet can be trimmed to match the shape of the bumper sticker. Velcro strips are used to mount the sheet and bumper sticker to a car bumper. Alternatively, adhesive materials in the form of double-sided tape are used in place of the Velcro strips. Courtney indicates that by trimming the mounting sheet, it becomes undetectable.

Appellant first submits it is improper to combine Courtney with German '696 as the two references are directed to distinct applications. The Examiner concludes that because both references share common subject matter of adhering a sticker on a mounting aid and mounting the resulting assembly to a surface of a vehicle, combination is proper. Such broad latitude in combining references would prevent most patent applications from ever being allowed as it is easy to find patents that would meet such a broad combination standard. The law requires the references themselves to contain some motivation to combine and this is still missing in these references. German '696 and Courtney are directed to different problems that show that combining them is not proper. German '696 is directed to a structure for displaying stickers on an inside surface of a windshield for viewing through the windshield as is Appellant's application. Courtney, however, is directed to mounting a bumper sticker to a car bumper, or

some other exterior surface of a vehicle. There is no disclosure or suggestion to use the invention on a windshield as there would be no reason to mount a bumper sticker on a car windshield. Also, as is clear by Courtney's teaching of how to mount the film onto the bumper sticker and where to mount the Velcro strips, one would not be led to the mounting structure of Appellant's invention as the bumper sticker could not be mounted on an inside surface of the windshield for viewing through the windshield as is claimed in Appellant's invention.

In addition, using a trimming step more naturally follows in Courtney because the application is designed for use on an exterior bumper surface of the car. The peripheral edges of the mounting aid will necessarily be exposed to the outdoor elements and would lead to deterioration of the edges such as becoming frayed or rolled up etc. This would lead to an unsightly assembly. Accordingly, without trimming in Courtney, the assembly would become worse over time. These concerns are not applicable in German '696 as the assembly is designed to be placed on an inside surface of the windshield. The assembly would not become worse over time because there is no direct exposure to outdoor elements. The benefits of trimming a film intermediary used with a sticker on an inside surface of a windshield are only learned from reading Appellant's disclosure. Furthermore, Courtney only discloses the use of Velcro strips or double-sided tape with the mounting sheet. Courtney does not disclose or suggest an adhesive layer or protective layer with the film as in Appellant's invention, further removing its applicability to Appellant's invention. Thus, the applications of German '696 and Courtney are quite distinct and different. As such, one would not apply the teachings of Courtney to German '696. Accordingly, the proposed combination of the references is not proper.

Furthermore, as discussed, German '696, like most of the other cited references, contains no disclosure or suggestion for the desirability of trimming. While Courtney makes a general statement that the bumper sticker can be placed in other locations (Based on the disclosure in Courtney, this obviously refers to other exterior locations on the vehicle.), there is no disclosure or suggestion in Courtney to use its mounting sheet with permit stickers on windshields. The Examiner states that making a mounting aid undetectable to the casual viewer and reducing the potential for theft by the appearance of permanent fixation provides a motivation to combine.

(Final Office Action, pg. 7.) The Examiner concludes that this benefit disclosed by Courtney is applicable to German '696 since the sticker assembly of both German '696 and Courtney are applied to a surface of a vehicle. (Final Office Action, pg. 8.) The only reason the Examiner can make this conclusion, however, is by relying on Appellant's claimed invention and using it as a template. German '696 contains no disclosure of a desirability for its film to be undetectable and further makes no statements regarding modifying or trimming the film so that it would be undetectable. Accordingly, this benefit is not applicable to German '696 and the Examiner cannot read this benefit into the reference. To the contrary, German '696 states that the film should be larger than the sticker and, therefore, expressly teaches away from the trimming element of claim 1. Thus, it is not even proper to attempt to combine Courtney with German '696.

German '696 teaches away from trimming because German '696 promotes a "one size fits all" product. German '696 states that the format is selected so that the majority and most common stickers can be stuck on it. (*See Declaration of Peter K. Kassab, Paragraph 7.*) Thus, the film in German '696 is sized such that it can be used with most stickers. The film, therefore, must at least be slightly larger than the largest stickers to assure its operability. The film cannot be undersized or else the high-tack adhesive on the sticker will extend past the film and be able to contact the receiving surface, thus rendering the film inoperable for its stated purpose. Accordingly, German '696 teaches to use a film that is larger than the sticker without any suggestion for trimming. One of ordinary skill in the art, with the knowledge of German '696, would not be led to the trimming step in Courtney because there is no indication in German '696 of a desirability to have the shape and size of the sticker and film match. Such express and material teaching away prevents a *prima facie* case of obvious with the proposed combination of German '696 and Courtney.

Furthermore, trimming is not readily known, as is supported by the attached Declaration of Peter K. Kassab, the individual inventor of the present invention. Appellant notes that contrary to the Examiner's assertion at page 9 of the Final Office Action, the article claims require the film to be trimmed to be in registry with edges of the sticker. Indeed, Appellant

developed the trimming step subsequent to his initial development of the invention. (Kassab Declaration, Paragraph 5.) Trimming was not immediately apparent to Appellant. It was only until Appellant worked with the film intermediary on different receiving surfaces did the benefits of having the film trimmed to be in registry with peripheral edges of the sticker become apparent. (Kassab Declaration, Paragraph 5.) Thus, the trimming aspect of the invention was not immediately apparent and was only developed after the initial aspects of the invention were developed. (Kassab Declaration, Paragraph 5.) Furthermore, over the course of time, Appellant has taken several questions from customers regarding the peripheral edges of the vinyl film extending beyond the peripheral edges of the sticker. (Kassab Declaration, Paragraph 8.) Appellant has had to indicate to the users to trim the edges as disclosed and claimed in the present application. Appellant has also observed his invention being used in the marketplace and has seen on several occasions that the user applied Appellant's product without following the directions to trim the film in registry with their windshield sticker. Another example of a sophisticated user not following Appellant's specific trimming instructions involved a commercial products catalog company. (Kassab Declaration, Paragraph 8.) Despite being experts on describing and creating published layouts for problem solving products, this specific catalog company created, published and distributed a national advertising layout showing the use of Appellant's product without trimming the film such that peripheral edges of the film were in registry with peripheral edges of the windshield sticker being used. This all occurred notwithstanding Appellant's specific product instructions and the product collateral material that explained the trimming step and its benefits. (Kassab Declaration, Paragraph 8.) Thus, the trimming element can hardly be considered as obvious. (Kassab Declaration, Paragraphs 4-9.)

In an attempt to extinguish the express teaching away in German '696, the Examiner attempts to read his own language into German '696. Ignoring the plain language of German '696, the Examiner claims that German '696 teaches that the "the film of the mounting aid *may* be larger than the sticker." (Final Office Action, pg. 9.) However, the German '696 patent says nothing of the sort. The German '696 patent specifically states that "The format is selected, so that the majority and most common stickers can be on it." As discussed above, this requires the

film to be slightly larger than the sticker. This is a positive, express statement contained in German '696. One needs no other analysis to come to this conclusion. Thus, the Examiner is reading the "*may be larger*" language into German '696 in an effort to ignore the express teaching away from the trimming element of claim 1. This is improper and shows why the proposed combination of German '696 and Courtney cannot establish a *prima facie* case of obviousness with respect to claim 1.

Appellant further notes that claim 1 requires a "vinyl film." German '696 and Courtney contain no disclosure or suggestion to use a vinyl film. Using a vinyl film assists in assuring the film can be suitably trimmed without problems as well as assuring that the film can withstand being suitably secured to a vehicle windshield. The attributes of the hard vinyl film is discussed in detail in the Specification at pages 22-26. For example, it is known to Appellant that certain plasticized films will shrink dramatically over time while attached to a sticker and being subjected to varying temperatures, causing the original window sticker adhesive to extend beyond the vinyl film intermediary. Appellant specifically specifies a vinyl film in his claims as this type of film can be suitably trimmed and secured to a windshield as described in the Specification. The Examiner randomly selects Japan '014 because it refers to a resin sheet of vinyl chloride. Japan '014, however, is directed to a method of producing sticker ornaments, and the reference to a resin sheet in Japan '014 is not for the purpose of a film intermediary as in the present invention. There is no disclosure or suggestion within the four corners of the Japan '014 reference that would give one the motivation to combine it with German '696 and Courtney. This is another example of the Examiner using Appellant's claims as a template to pick and choose elements of the prior art without the requisite motivation to combine found specifically in the references themselves. The Examiner has merely applied hindsight reconstruction.

In sum, the majority of the cited art is simply void of the trimming element as claimed. As discussed above, Courtney is not properly combinable with German '696. In addition, German '696 expressly teaches away from the proposed combination. Other references required for the Examiner's proposed combination similarly lack the specific disclosure for the motivation to combine. Thus, the proposed combination cannot establish a *prima facie* case of obviousness

with respect to claim 1. Accordingly, Appellant submits that claim 1 is patentably distinct over the cited references.

b. Claim 2

Claim 2 requires, among other things, “trimming the vinyl film thereby placing peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker.” For the reasons stated with respect to claim 1, Appellant submits that claim 2 is patentably distinct over the cited references.

c. Claim 4

Claim 4 depends from claim 2 and includes all of the elements of claim 2. Appellant submits that claim 4 is patentably distinct for the same reasons with respect to claim 2.

d. Claim 5

Claim 5 depends from claim 2 and includes all of the elements of claim 2. Appellant submits that claim 5 is patentably distinct for the same reasons with respect to claim 2.

e. Claim 6

Claim 6 requires, among other things, that “the vinyl film is trimmed such that peripheral edges of the vinyl film are essentially in registry with peripheral edges of the window sticker” and that “the indicia-bearing sticker is viewable through the window from outside of the vehicle and the vinyl film is undetectable when viewed through the window from outside of the vehicle.” Claim 6 requires a similar trimming element as in claim 1. For the reasons stated with respect to claim 1, Appellant submits that the several different references are not properly combinable, and claim 6 is also patentably distinct over the cited references.

f. Claim 11

Claim 11 requires, among other things, the step of “trimming the vinyl film thereby placing the peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker.” Claim 11 requires a similar trimming element as in claim 1. For the reasons stated with respect to claim 1, Appellant submits that the several different references are not properly combinable, and claim 11 is patentably distinct over the cited art.

g. Claim 13

Claim 13 requires, among other things, “trimming the first strip of vinyl film to correspond in size to the first strip of adhesive on the sticker” and “trimming the second strip of vinyl film to correspond in size to the second strip of adhesive on the sticker.” Claim 13, therefore, requires a similar trimming element as in claim 1. For the reasons stated with respect to claim 1, Appellant submits that the several different references are not properly combinable, and claim 13 is patentably distinct over the cited art.

h. Claim 14

Claim 14 further requires “a first non-perforated strip of vinyl film having a first side and a second side, the second side of the first strip of film having a low-tack adhesive thereon and a first protective layer positioned over the low-tack adhesive, the first strip of vinyl film and first protective layer being trimmed to correspond in size to the first strip of adhesive of the sticker.” Claim 14 also requires “a second non-perforated strip of vinyl film having a first side and a second side, the second side of the second strip of film having a low-tack adhesive thereon and a second protective layer positioned over the low-tack adhesive, the second strip of film and second protective layer being trimmed to correspond in size to the second strip of adhesive of the sticker.” Thus, claim 14 requires a similar trimming element as in claim 1. For the reasons stated with respect to claim 1, Appellant submits that the several different references are not properly combinable, and claim 14 is patentably distinct over the cited art.

i. Claim 22

Claim 22 requires, among other things, strips of vinyl film wherein “the strips are trimmed to correspond in size to the strips of adhesive.” Claim 22 requires a trimming element similar to claims 1 and 13. For the reasons stated with respect to claims 1 and 13, Appellant submits that the several different references are not properly combinable, and claim 22 is patentably distinct over the cited art.

j. Claim 23

Claim 23 requires, among other things, “a continuous, uninterrupted layer of optically clear vinyl film having a first side and a second side, the second side having a low-tack adhesive

thereon and a protective layer positioned over the low-tack adhesive, the first side adapted to be adhered directly to the adhesive layer of the window sticker wherein the adhesive layer is adapted to fixedly attach the window sticker to the first side of the vinyl film and wherein the vinyl film and protective layer are trimmed such that peripheral edges of the vinyl film and protective layer are adapted to be essentially in registry with peripheral edges of the window sticker.” Thus, the intermediary of claim 23 requires a vinyl film and protective layer that must be trimmed, similar to the trimming element recited in claim 1. For the reasons stated above with respect to claim 1, Appellant submits claim 23 is patentably distinct over the cited art.

k. Claim 24

Claim 24 is directed to a sticker assembly utilizing a strip of vinyl film that “is trimmed to correspond in size to the strip of adhesive” on the sticker. For the reasons stated with respect to claims 1 and 13, Appellant submits that the several different references are not properly combinable, and claim 24 is patentably distinct over the cited art..

In view of the above, the several different references are not properly combinable. The Examiner has used Appellant's claims as a template for his conclusions of obviousness without the requisite motivation to combine. German '696 and Courtney are particularly not combinable as the references have different application, and German '696 expressly teaches away from the proposed combination. The references, therefore, cannot establish a *prima facie* case of obviousness. Accordingly, Appellant submits that claims 1, 2, 4, 5, 6, 11, 13, 14, 22, and 24 are patentably distinct over the cited art.

3. German '696, Courtney, Japan '014 and at Least One of the Admitted Prior Art (Specification pgs. 1-3, pg. 18, lns. 12-17), Great Britain '233 and Langen Do Not Disclose or Suggest All Limitations of Claims 6, 11, 13, 14, 22, and 24

In addition to the reasons discussed above, claims 6, 11, 13, 14, 22 and 24 are further patentable as the Examiner's proposed combination does not meet all of the recited claim elements.

a. Claim 6

Claim 6, requires a “protective layer positioned over the low-tack adhesive” wherein “the vinyl film and protective layer are trimmed such that peripheral edges of the vinyl film and protective layer are essentially in registry with peripheral edges of the window sticker.” As shown in FIG. 16, the vinyl film 100 has a protective layer 108 or liner. As explained on page 23, ln. 28 to page 24, ln. 12 of the Specification, the vinyl film 100 and protective layer 108 are trimmed to place the peripheral edges in registry. With the protective layer 108, the assembly is stiffer, which assists in the trimming of the peripheral edges of the sticker because the scissors have better resistance with the stiffer protective layer on the more floppy film. The protective layer 108 also prevents exposure of the film until just before it is to be mounted helping to keep the film as clean as possible and void of dust particles or natural hand oils, which could affect adherence to the windshield. None of the cited prior art disclose a protective layer for a film that is trimmed with the film. As discussed above, German ‘696 contains no disclosure or suggestion for trimming the film and actually teaches away from using a trimming step. While Courtney discloses a trimming step, Courtney does not disclose or suggest using a protective layer or trimming a protective layer along with the film. There is no disclosure or suggestion in Courtney for using a protective layer with the mounting sheet 11. Because Courtney utilizes Velcro strips, Courtney would not have a need for a protective layer with the mounting sheet. There is also no need for a protective layer if a double-sided tape was used in the Courtney device. With such mounting devices, there is no disclosure or suggestion for trimming a protective layer when trimming the mounting sheet. None of the remaining prior art discloses a protective layer that is trimmed as claimed. In sum, claim 6 requires that the protective layer is trimmed along with the vinyl film such that peripheral edges of the vinyl film and protective layer are essentially in registry. Thus, even if it was proper to combine the several different references as proposed by the Examiner, the proposed combination does not meet all of the elements of claim 6. Accordingly, Appellant submits that claim 6 is patentably distinct over the cited references.

b. Claim 11

Claim 11 also requires, among other things, providing “a protective layer positioned over the low-tack adhesive” and “trimming the vinyl film and protective layer thereby placing peripheral edges of the vinyl film and protective layer in registry with peripheral edges of the windshield sticker.” For the reasons stated with respect to claim 6, Appellant submits that claim 11 is patentably distinct over the cited art.

c. Claim 13

Claim 13 requires, among other things, “trimming the first strip of vinyl film to correspond in size to the first strip of adhesive on the sticker” and “trimming the second strip of vinyl film to correspond in size to the second strip of adhesive on the sticker.” The Examiner makes several general statements on pages 11 and 12 of the Final Office Action regarding first and second strips of vinyl film as recited in claim 13. As explained in greater detail below, none of the references cited by the Examiner discloses these elements.

The Examiner's statements regarding the several different references does not result in the use of strips of vinyl film that are trimmed in a method of releasably adhering a vehicle windshield sticker to a windshield. German '696 is completely void of any disclosure or suggestion to use vinyl strips. (See also Kassab Declaration, Paragraph 7.) The prior art temporary permit stickers utilizing spaced strips of adhesive further do not suggest the use of vinyl strips and no convincing line of reasoning follows therefrom. At best, one could only argue to use an entire sheet of film from German '696 over the prior art permit sticker that would cover both the strips of adhesive and the indicia bearing portion between the strips of the adhesive. However, that structure is not claimed in claim 13. In addition, such configuration would be undesirable because one could then detect the film over the indicia-bearing portion of the sticker where there is no adhesive applied. Consistent with the arguments above, the vinyl strips of film over the adhesive strips are undetectable. Additionally, if the film covered the entire indicia-bearing surface, the film would prevent writing registration dates, times etc., that are required on many of these temporary permit stickers.

Furthermore, even if Langen is read to suggest removably securing a sticker using spaced strips of repositionable adhesive, Langen does not disclose or suggest using strips of vinyl film that are trimmed. Langen discloses using a repositionable adhesive and release strip including a double-sided tape 34 having a release liner 37. (*See e.g.*, col. 3, lns. 58-59; col. 4, lns. 47-57). The strips in Langen are merely tape strips and there is still no suggestion for using strips of vinyl film with strips of adhesive. Accordingly, it is not proper to conclude that German '696 and Langen fairly suggest the use of strips as recited in claim 13.

In addition, Langen, does not teach trimming strips of vinyl film. Langen merely discloses the use of a double-sided tape having a repositionable adhesive. (*See e.g.*, col. 3, lns. 58-59; col. 4, lns. 47-57). As there is no disclosure or suggestion of trimming, the adhesive and release liner must initially be made the same size in Langen. Furthermore, neither the tape 34 nor the release liner 37 is a vinyl film that is trimmed to correspond in size to a separate strip of adhesive. The tape 34 is an integral assembly with adhesive on both its sides. Thus, if a double-sided tape is used, the release liner is automatically sized wherein there is no need for another trimming operation. There is plainly no disclosure or suggestion of a step of trimming a strip of vinyl film to correspond in size to the first strip of adhesive on the sticker. In fact, Langen teaches away from such a configuration as it discloses that the application of adhesive and protective strips is done simultaneously (*See Abstract*). Thus, the proposed combination of any of the references with Langen does not render as obvious, the trimming step as claimed. Therefore, the proposed combination cannot establish a *prima facie* case of obviousness with respect to claim 13.

From the above statements with respect to German '696, the prior art temporary permit stickers and Langen, the Examiner further concludes that trimming the strips would have been obvious in view of above noted suggestion from the applied prior art to use a pair of film strips instead of one film strip. As noted above, the prior art does not support this conclusion because none of the prior art relied upon by the Examiner discloses or suggests the use of a pair of film strips. German '696 is completely void of such teaching. The prior art temporary permit stickers only teaches the use of strips of adhesive, not the use of a pair of film strips. Similarly, Langen

only teaches the use of a strip of repositionable adhesive including a double-sided tape. None of the cited prior art discloses or suggests the use of strips of vinyl film that are trimmed to correspond to adhesive strips as claimed in claim 13. The only disclosure of this element is found in Appellant's specification. Appellant further notes that the trimming of strips was only developed after further experimentation, and not readily apparent. (Kassab Declaration, Paragraph 6.)

Courtney merely discloses trimming an entire mounting sheet to correspond in size to a bumper sticker. Courtney does not disclose or suggest using strips of vinyl film that are trimmed to correspond in size to strips of adhesive. Furthermore, there would be no motivation in Courtney to use strips of film because Courtney only teaches the use of Velcro strips and double-sided tape as mounting structures, thus making the need for strips unnecessary. Rather, Courtney is focused on trimming to size based on the sticker size as opposed to the size of the adhesive strip as in claim 13.

In sum, the several references do not disclose or suggest strips of vinyl film, and further do not support that the use of strips as claimed was within the knowledge generally available to one of ordinary skill in the art. Accordingly, a rejection based on a *prima facie* case of obviousness cannot be supported. M.P.E.P. §2143.01. Accordingly, claim 13 is patentably distinct over the cited art.

Finally, Appellant notes and appreciates the indication of allowable subject matter with respect to claim 16. Appellant submits that the Examiner's reasons for allowance equally apply to claim 13. Accordingly and consistent with the Examiner's reasoning regarding claim 16, although the use of space strips of adhesive is known in the prior art, there is no motivation to modify the film of the prior art so as to include the step of placing strips of vinyl film coinciding with the strips of adhesive. It is noted that the prior art, such as German '696, like Great Britain '256, does not disclose using strips of vinyl film, but teaches covering the entire surface of a vehicle window sticker with the film. The Examiner makes a distinction that claim 16 requires static cling strips rather than vinyl strips. This is irrelevant as the reason for patentability is not based on material, but rather on the fact that the intermediary is in the form of spaced strips that

coincide with strips of adhesive. For these same reasons, Appellant submits that claim 13 is patentably distinct over the cited art.

d. Claim 14

Claim 14 further requires “a first non-perforated strip of vinyl film having a first side and a second side, the second side of the first strip of film having a low-tack adhesive thereon and a first protective layer positioned over the low-tack adhesive, the first strip of vinyl film and first protective layer being trimmed to correspond in size to the first strip of adhesive of the sticker.” Claim 14 also requires “a second non-perforated strip of vinyl film having a first side and a second side, the second side of the second strip of film having a low-tack adhesive thereon and a second protective layer positioned over the low-tack adhesive, the second strip of film and second protective layer being trimmed to correspond in size to the second strip of adhesive of the sticker.” Thus, claim 14 requires first and second strips of film having protective layers wherein the strips and protective layers are trimmed. For the reasons stated with respect to claims 1, 11 and 13, Appellant submits that the several different references do not disclose all of the elements of claim 14 and, therefore, cannot establish a *prima facie* case of obviousness. Claim 14 is patentably distinct over the cited art.

e. Claim 22

Claim 22 requires, among other things, strips of vinyl film wherein “the strips are trimmed to correspond in size to the strips of adhesive.” Claim 22 requires a trimming element similar to claims 1 and 13. For the reasons stated with respect to claims 1 and 13, Appellant submits that the several different references do not disclose all of the elements of claim 22 and, therefore, cannot establish a *prima facie* case of obviousness. Claim 22 is patentably distinct over the cited art.

f. Claim 24

Claim 24 is directed to a sticker assembly utilizing a strip of vinyl film that “is trimmed to correspond in size to the strip of adhesive” on the sticker. For the reasons stated with respect to claims 1 and 13, Appellant submits that the several different references do not disclose all of

the elements of claim 24 and, therefore, cannot establish a *prima facie* case of obviousness. Claim 24 is patentably distinct over the cited art.

**C. Langen and Honaker or Yoshida Do Not Render
Claims 1, 14, and 22 Obvious**

In the Final Office Action, the Examiner rejected claims 1, 14, and 22 under 35 U.S.C. §103 as being unpatentable over Langen in view of U.S. Patent No. 4,935,288 to Honaker (“Honaker”) or U.S. Patent No. 4,670,490 to Yoshida et. al (“Yoshida”). Appellant respectfully submits the Examiner has erred in maintaining this Section 103 rejection and respectfully requests reversal of this rejection.

**1. There is No Suggestion or Motivation to Combine Langen
and Honaker or Yoshida**

As an initial ground for overcoming the rejection, Appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness because there is no suggestion or motivation to combine Langen and Honaker or Yoshida as suggested by the Examiner. Langen is directed to a repositional window pricing label while Honaker is directed to a coated laser printed label. Even though both Langen, Honaker, and Yoshida are directed to labels, the Examiner has still failed to cite to a specific disclosure in any of the references that would have given one the motivation to combine them as proposed by the Examiner. Consequently, the proposed combination cannot establish a *prima facie* case of obviousness with respect to the claims. M.P.E.P §2143.01.

**2. Langen and Honaker or Yoshida Do Not Suggest All
Limitations of Claims 1, 14, and 22**

As another ground for overcoming the rejection, the combination of Langen, Honaker and Yoshida does not disclose or suggest all of the elements of the claims.

a. Claim 1

Claim 1 requires, among other things, that “the vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker.” This element is not disclosed or suggested in Langen. Honaker and Yoshida are completely void of any such disclosure. In addition, Langen does not

teach cutting a vinyl film to have peripheral edges in registry with the sticker. Langen discloses the use of a repositionable adhesive and release strip and the use of double-sided tape 34 having a release liner 37. (*See e.g.*, col. 3, lns. 58–59; col. 4, lns. 47–57.) The slitting and bursting reference in Langen, previously relied on by the Examiner to support his position, refers to the web 12 in Langen, not to the film. As there is no disclosure or suggestion of trimming, the adhesive and release liner must initially be made the same size in Langen. The structure of claim 1 is distinguishable from Langen because the film of the claimed invention has a trimmed edge and the structure in Langen does not. This structural difference is present in the end product. *See* M.P.E.P. §2113. Furthermore, in the double-sided tape embodiment, neither the tape 34 or the release liner 37 is a vinyl film that is trimmed to be in registry with the sticker. The tape 34 is an integral assembly with adhesive on both its sides. Thus, if a double-sided tape is used, the release liner is automatically sized wherein there is no need for another trimming operation. There is plainly no disclosure or suggestion of a step of trimming a vinyl film to correspond in size to a sticker. In fact, Langen teaches away from such a configuration as it discloses that the application of adhesive and protective strips is done simultaneously (*see* Abstract). And as discussed, the slitting and bursting reference is for the web 12 and not to the tape 34.

The cited art is simply void of the trimming element as claimed. Thus, the proposed combination of Langen, Honaker, and Yoshida does not render the trimming step as claimed obvious. Accordingly, the proposed combination cannot establish a *prima facie* case of obviousness with respect to claim 1. Appellant submits that claim 1 is patentably distinct over the cited references.

b. Claim 14

Claim 14 requires, among other things, that “the strips are trimmed to correspond in size to the strips of adhesive.” Claim 14 also requires a “protective layer” that is trimmed as discussed above. Claim 14 further requires that “the strips are undetectable when viewable through the windshield from outside of the vehicle.”

Further as discussed above, Langen does not teach cutting strips of vinyl film. Langen discloses the use of a repositionable adhesive and release strip and the use of double-sided tape 34 having a release liner 37. (*See e.g.*, col. 3, lns. 58–59; col. 4, lns. 47–57.) Neither the tape 34 nor the release liner 37 is a vinyl film that is trimmed and to correspond in size to a separate strip of adhesive. The tape 34 is an integral assembly with adhesive on both its sides. Thus, if a double-sided tape is used, the release liner is automatically sized wherein there is no need for another trimming operation. There is no disclosure or suggestion of a step of trimming a strip of vinyl film to correspond in size to the first strip of adhesive on the sticker. In fact, Langen teaches away from such a configuration as it discloses that the application of adhesive and protective strips is done simultaneously (*see* Abstract). For the reasons stated above, Appellant submits that claim 14 is patentably distinct over the cited art.

In addition, the cited prior art does not disclose a protective layer for a film that is trimmed with the film as claimed. Because Langen utilizes adhesive strips and double-sided tape, Langen would not have a need for a protective layer that is trimmed as claimed. With such mounting devices, there is no disclosure or suggestion for trimming a protective layer when trimming the film. None of the remaining prior art discloses a protective layer that is trimmed as claimed. Thus, even if it was proper to combine the references as proposed by the Examiner, the proposed combination does not meet all of the elements of claim 14.

c. Claim 22

Claim 22 requires, among other things, strips of vinyl film wherein “the strips are trimmed to correspond in size to the strips of adhesive.” For the reasons stated with respect to claims 1 and 14, Appellant submits that claim 22 is patentably distinct over the cited art.

**D. German ‘696 and Japan ‘014 and Either Great Britain ‘233
or Langen Do Not Render Claim 23 Obvious**

In the Final Office Action, the Examiner rejected claim 23 under 35 U.S.C. §103 as being unpatentable over German Patent No. DE 29720696 (“German ‘696”) in view of Japan Patent No. 9-97014 (“Japan ‘014”) and further in view of at least one of Great Britain Patent No. 2174233 (“Great Britain ‘233”) and U.S. Patent No. 5,290,067 to Langen (“Langen”). Appellant

respectfully submits the Examiner has erred in maintaining this Section 103 rejection and respectfully requests reversal of this rejection.

1. There is No Suggestion or Motivation to Combine

Claim 23 discloses an intermediary for a window sticker. Claim 23 requires, among other things, “a continuous, uninterrupted layer of optically clear vinyl film having a first side and a second side, the second side having a low-tack adhesive thereon and a protective layer positioned over the low-tack adhesive, the first side adapted to be adhered directly to the adhesive layer of the window sticker wherein the adhesive layer is adapted to fixedly attach the window sticker to the first side of the vinyl film and wherein the vinyl film and protective layer are trimmed such that peripheral edges of the vinyl film and protective layer are adapted to be essentially in registry with peripheral edges of the window sticker.” Thus, the intermediary of claim 23 requires a vinyl film and protective layer that must be trimmed, similar to the trimming element recited in claim 1.

Appellant submits that the arguments outlined above in Section C equally apply to this rejection and show that the Examiner's proposed combination cannot establish a *prima facie* case of obviousness. As discussed above, the Examiner has not pointed to any specific disclosure in the cited references that would give one of skill in the art a motivation to combine the several different references as suggested by the Examiner. For example, while Japan '014 discloses a vinyl resin sheet, there is no specific disclosure in German '696 or Japan '014 that would give one the motivation to combine them. The other references also lack specific disclosures to give a motivation to combine. Indeed, after multiple office actions, the Examiner continues to fail to cite to any such specific disclosures in the references themselves. This illustrates the Examiner's required use of hindsight reconstruction to piece together elements of unrelated pieces of prior art to reject Appellant's claims. As discussed, the suggestion to combine requirement prevents such practice. *Yamanouchi Pharmaceutical*, 231 F.3d 1339, 56 USPQ2d at 1644. Accordingly, Appellant respectfully submits that the Examiner has therefore failed to establish a *prima facie* case of obviousness.

2. German '696 and Japan '014 and at Least One of Great Britain '233 and Langen Do Not Disclose or Suggest All Limitations of Claim 23

Appellant further submits claim 23 is allowable because German '696, Japan '014, Great Britain '233, and Langen do not disclose or suggest all the limitations of claim 23.

As discussed, claim 23 requires trimming of the vinyl film and trimming of the protective layer. For the reasons stated above in Section C, Appellant submits claim 23 is allowable. Briefly, German '696 does not disclose or suggest a trimming element, but rather expressly teaches away from trimming. Claim 23 requires that the vinyl film is trimmed wherein peripheral edges of the vinyl film are adapted to be essentially in registry with peripheral edges of the window sticker. Thus, contrary to the Examiner's unsupported contention (*see* Final Office Action, pg. 4), the edges of the film claimed in claim 23 are structurally different from the edges in German '696 as the German '696 edges are not trimmed. Furthermore, German '696 contains no disclosure or suggestion to also trim a protective layer. Similarly, Japan '014, Great Britain '233 and Langen also do not disclose or suggest trimming a vinyl film and protective layer as claimed in claim 23. Accordingly, even if it was proper to combine the several different references as proposed by the Examiner, the combination does not meet all of the elements of claim 23. Consequently, the proposed combination cannot establish a *prima facie* case of obviousness with respect to claim 23, and Appellant submits that claim 23 is patentably distinct over the cited art.

E. Appellant's Invention Has Been Well-Received in the Marketplace

Appellant submits that the above arguments show that the Examiner's obviousness rejections are not proper. In addition to the above, Appellant further notes that his invention has been well-received in the marketplace as previously noted during the prosecution of the application. (*See* Kassab Declaration, Paragraph 9.) At the time of submitting Appellant's Declaration, over 100,000 units of the product were sold at that time in 2004. Furthermore, Appellant advises the undersigned attorney that by the end of 2004, over 182,000 units of the product were sold. Appellant further advises the undersigned attorney that over 250,000 units of the product have been sold since the introduction of the product. Appellant knows of no other competitive offerings, and Appellant's sales continue to increase year after year. Trimming has

always been an aspect of Appellant's commercial product as the trimming aspect has been highlighted on the packaging for Appellant's product.

The Examiner's comments regarding Appellant's Declaration in the final Office Action were generally non-responsive to Appellant's evidence. The Examiner expressed confusion regarding the Declaration because he concluded that the relationship between Appellant's reference to "my product" and the claimed invention was not clear. (*See* Final Office Action, pg. 14.) The Examiner concluded that the evidence in the declaration is not commensurate in scope with the claims since sales of the product appear to be for the untrimmed sticker assembly instead of the trimmed sticker assembly. *Id.* It is clear from a reading of Appellant's application, that the end user trims the film intermediary thus making a sticker assembly as claimed. Appellant would be unable to sell a trimmed film as it is readily understood that the end user must trim the film intermediary according to the size of the window sticker being used by the end user. The sizes of the multitude of stickers that can be used by the end user obviously vary. Thus, the Examiner's conclusions regarding Appellant's Declaration are irrelevant because it places an impossible burden on Appellant. Appellant cannot sell "trimmed" product units as it is the end user who trims the film. The Examiner's comments have resulted in an improper disregard of Appellant's evidence. In sum, Appellant's product as claimed has had a practical impact and been well-received in the marketplace. This evidence further supports that the pending claims are allowable over the cited prior art.

VIII. CONCLUSION

For the foregoing reasons, Appellant respectfully requests that the Board reverse the Examiner's rejections, and order that claims 1, 2, 4, 5, 6, 11, 13, 14, 16, and 22-24 be passed to issue.

Respectfully submitted,

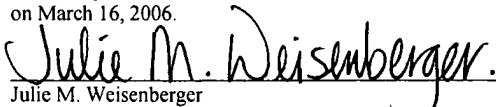
Date: March 16, 2006

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CERTIFICATE OF MAILING

I hereby certify that this correspondence and fee are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: MAIL STOP APPEAL BRIEF - PATENTS, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on March 16, 2006.


Julie M. Weisenberger

CLAIMS APPENDIX

1. (Previously Presented) A sticker assembly comprising:
a sticker having an indicia-bearing surface, the sticker having peripheral edges;
a non-perforated layer of vinyl film having a first side and a second side, the second side having a low-tack adhesive layer, the vinyl film having outer edges; and

an adhesive disposed between the sticker and the first side of the film resulting in direct contact of the adhesive with the vinyl film and fixedly attaching the sticker to the vinyl film and wherein the indicia-bearing surface is viewable through a receiving surface, and wherein the vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing the peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker, and wherein the second side of the vinyl film is adapted be releasably adhered to a receiving surface.

2. (Previously Presented) A method of releasably adhering a vehicle windshield sticker to a vehicle windshield, the method comprising:

providing an indicia-bearing windshield sticker having an adhesive layer thereon;

providing a continuous, uninterrupted layer of vinyl film having a first side and a second side, the second side having a low-tack adhesive thereon;

adhering the sticker to the first side of the vinyl film via the adhesive layer wherein the adhesive layer is in direct contact with the first side of the film and wherein the adhesive layer fixedly attaches the sticker to the first side of the film;

trimming the vinyl film thereby placing peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker to form a sticker assembly; and

adhering the sticker assembly to the windshield by placing the second side of the vinyl film against the windshield wherein the low-tack adhesive releasably adheres to the windshield and wherein the indicia is viewable through the windshield and wherein the sticker assembly can be peeled off the windshield without damage to the sticker.

3. (Canceled)

4. (Previously Presented) The method of Claim 2 wherein the adhesive layer on the windshield sticker has spaced strips of adhesive and the method further including the step of placing strips of vinyl film coinciding with the strips of adhesive, the strips of vinyl film having a low-tack adhesive thereon for releasably adhering to the windshield.

5. (Previously Presented) The method of Claim 2 wherein the vinyl film is optically clear.

6. (Previously Presented) A sticker assembly for a vehicle having a window, the assembly comprising:

an indicia-bearing window sticker having an adhesive layer;

a continuous, uninterrupted layer of optically clear vinyl film having a first side and a second side, the second side having a low-tack adhesive thereon and a protective layer positioned over the low-tack adhesive, the first side adhered directly to the adhesive layer of the window sticker wherein the adhesive layer fixedly attaches the window sticker to the first side of the vinyl film and wherein the vinyl film is and protective layer are trimmed such that peripheral edges of the vinyl film and protective layer are essentially in registry with peripheral edges of the window sticker; and,

upon removal of the trimmed protective layer, the low-tack adhesive on the second side of the vinyl film is releasably adhereable to the window wherein the indicia-bearing sticker is viewable through the window from outside of the vehicle and the vinyl film is undetectable when viewed through the window from outside of the vehicle.

7. (Canceled)

8. (Canceled)

9. (Canceled)

10. (Canceled)

11. (Previously Presented) A method of releasably adhering a vehicle windshield sticker to a vehicle windshield, the method comprising:

providing an indicia-bearing windshield sticker having an adhesive layer thereon;

providing a non-perforated layer of vinyl film having a first side and a second side, the second side having a low-tack adhesive thereon and a protective layer positioned over the low tack adhesive;

positioning the first side of the film over the adhesive on the sticker and adhering the first side of the film directly to the adhesive such that the vinyl film cannot be separated from the adhesive without destroying the vinyl film and the sticker;

trimming the vinyl film and protective layer thereby placing peripheral edges of the vinyl film and protective layer in registry with peripheral edges of the windshield sticker; and

upon removal of the trimmed protective layer, the sticker and adhesive, and the layer of vinyl film defining a sticker assembly, releasably adhering the sticker assembly to the windshield by placing the second sides of the vinyl film against the windshield so that the low-tack adhesive on the second side of the vinyl film is positioned against the windshield and so that the indicia is viewable through the windshield and wherein the sticker assembly can be peeled off the windshield without damage to the sticker.

12. (Canceled)

13. (Previously Presented) A method of releasably adhering a vehicle windshield sticker to a vehicle windshield, the method comprising:

providing an indicia-bearing windshield sticker having an adhesive layer thereon, the adhesive layer comprising a first strip of adhesive positioned along a peripheral edge of the sticker and a second strip of adhesive positioned along an opposite peripheral edge of the sticker, wherein an indicia bearing portion of the sticker does not have adhesive over that portion;

providing a first non-perforated strip of vinyl film having a first side and a second side, the second side having a low-tack adhesive thereon;

trimming the first strip of vinyl film to correspond in size to the first strip of adhesive on the sticker;

providing a second non-perforated strip of vinyl film having a first side and a second side, the second side of the second strip of film having a low-tack adhesive thereon;

trimming the second strip of vinyl film to correspond in size to the second strip of adhesive on the sticker;

positioning the first side of the first strip of film to correspond to the first strip of adhesive and adhering the first side of the first strip of film directly to the first strip of adhesive such that the first strip of film cannot be separated from the first strip of adhesive without destroying the first strip of film and the sticker; and

positioning the first side of the second strip of film to correspond to the second strip of adhesive and adhering the first side of the second strip of film directly to the second strip of adhesive such that second strip of film cannot be separated from the second strip of adhesive without destroying the second strip of film and the sticker;

the sticker, the first and second strips of adhesive and the first and second strips of vinyl film defining a sticker assembly, releasably adhering the sticker assembly to the windshield by

placing the second sides of the strips of vinyl film against the windshield so that the low-tack adhesive on the second side of the first strip of vinyl film is positioned against the windshield and the low-tack adhesive on the second side of the second strip of vinyl film is positioned against the windshield and so that the indicia is viewable through the windshield and wherein the sticker assembly can be peeled off the windshield without damage to the sticker.

14. (Previously Presented) A sticker assembly for a vehicle having a windshield, the assembly comprising:

an indicia-bearing windshield sticker having an indicia-bearing substrate with an adhesive layer disposed on the substrate, the adhesive layer comprising a first strip of adhesive positioned along a peripheral edge of the sticker and a second strip of adhesive positioned along an opposite peripheral edge of the sticker;

a first non-perforated strip of vinyl film having a first side and a second side, the second side of the first strip of film having a low-tack adhesive thereon and a first protective layer positioned over the low-tack adhesive, the first strip of vinyl film and first protective layer being trimmed to correspond in size to the first strip of adhesive of the sticker and upon removal of the first protective layer, the first side of the first strip of film positioned to correspond to the first strip of adhesive and adhered directly to the first strip of adhesive such that the first strip of film cannot be separated from the first strip of adhesive without destroying the first strip of film and the sticker; and

a second non-perforated strip of vinyl film having a first side and a second side, the second side of the second strip of film having a low-tack adhesive thereon and a second protective layer positioned over the low-tack adhesive, the second strip of vinyl film and second protective layer being trimmed to correspond in size to the second strip of adhesive of the sticker and upon removal of the second protective layer, the first side of the second strip of film positioned to correspond to the second strip of adhesive and adhered directly to the second strip of adhesive such that the second strip of film cannot be separated from the second strip of adhesive without destroying the second strip of film and the sticker;

wherein the second sides of the strips of vinyl film are capable of being releasably adhereable to the windshield so that the indicia-bearing substrate is viewable through the windshield from outside of the vehicle, and the indicia bearing portion of the sticker does not have adhesive over that portion, and the strips are trimmed to correspond in size to the strips of

adhesive, and wherein the strips are undetectable when viewable through the windshield from outside of the vehicle.

15. (Canceled)

16. (Previously Presented) A method of releasably adhering a vehicle windshield sticker to a vehicle windshield, the method comprising:

providing an indicia-bearing windshield sticker having an adhesive layer thereon, wherein the adhesive layer on the windshield sticker has spaced strips of adhesive;

providing a non-perforated layer of static-cling film having a first side and a second side, the second side holding a static charge, wherein the static-cling film has spaced strips of film;

placing the strips of static-cling film coinciding with the strips of adhesive to adhere the sticker to the first side of the strips of static-cling film via the adhesive layer wherein the adhesive layer is in direct contact with the first side of the strips of film and wherein the adhesive layer fixedly attaches the sticker to the first side of the strips of film to form a static-cling sticker assembly; and

adhering the static-cling sticker assembly to the windshield by placing the second side of the strips of static-cling film against the windshield wherein the indicia is viewable through the windshield and wherein the static-cling sticker assembly can be peeled off the windshield without damage to the sticker.

17. (Canceled)

18. (Canceled)

19. (Canceled)

20. (Canceled)

21. (Canceled)

22. (Previously Presented) A sticker assembly for a vehicle having a windshield, the assembly comprising:

an indicia-bearing windshield sticker having an indicia-bearing substrate with an adhesive layer disposed on the substrate, the adhesive layer comprising a first strip of adhesive positioned on the substrate and a second strip of adhesive positioned on the substrate;

a first non-perforated strip of vinyl film having a first side and a second side, the second side of the first strip of film having a low-tack adhesive thereon, the first side of the first strip of film positioned to correspond to the first strip of adhesive and adhered directly to the first strip of

adhesive such that the first strip of film cannot be separated from the first strip of adhesive without destroying the first strip of film and the sticker; and

a second non-perforated strip of vinyl film having a first side and a second side, the second side of the second strip of film having a low-tack adhesive thereon, the first side of the second strip of film positioned to correspond to the second strip of adhesive and adhered directly to the second strip of adhesive such that the second strip of film cannot be separated from the second strip of adhesive without destroying the second strip of film and the sticker;

wherein the second sides of the strips of vinyl film are capable of being releasably adhereable to the windshield so that the indicia-bearing substrate is viewable through the windshield from outside of the vehicle, and the strips are trimmed to correspond in size to the strips of adhesive.

23. (Previously Presented) An intermediary for a window sticker for a vehicle having a window, the sticker being an indicia-bearing window sticker having an adhesive layer, the intermediary comprising:

a continuous, uninterrupted layer of optically clear vinyl film having a first side and a second side, the second side having a low-tack adhesive thereon and a protective layer positioned over the low-tack adhesive, the first side adapted to be adhered directly to the adhesive layer of the window sticker wherein the adhesive layer is adapted to fixedly attach the window sticker to the first side of the vinyl film and wherein the vinyl film and protective layer are trimmed such that peripheral edges of the vinyl film and protective layer are adapted to be essentially in registry with peripheral edges of the window sticker; and,

upon removal of the trimmed protective layer, the low-tack adhesive on the second side of the vinyl film is releasably adhereable to the window wherein the indicia-bearing sticker is viewable through the window from outside of the vehicle and the vinyl film is undetectable when viewed through the window from outside of the vehicle.

24. (Previously Presented) A sticker assembly for a vehicle having a windshield, the assembly comprising:

an indicia-bearing windshield sticker having an indicia-bearing substrate with an adhesive layer disposed on the substrate, the adhesive layer comprising a strip of adhesive positioned along a peripheral edge of the sticker; and

a non-perforated strip of vinyl film having a first side and a second side, the second side of the strip of film having a low-tack adhesive thereon, the first side of the strip of film positioned to correspond to the strip of adhesive and adhered directly to the strip of adhesive such that the strip of film cannot be separated from the strip of adhesive without destroying the strip of film and the sticker,

wherein the second side of the strip of vinyl film is capable of being releasably adhereable to the windshield so that the indicia-bearing substrate is viewable through the windshield from outside of the vehicle, and the strip is trimmed to correspond in size to the strip of adhesive, and wherein the strip is undetectable when viewable through the windshield from outside of the vehicle.

EVIDENCE APPENDIX - KASSAB DECLARATION

The Kassab Declaration was entered into the record on October 20, 2004. The Declaration was submitted to the Office along with the Reply to the May 20, 2004 Office Action.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Peter K. Kassab)
Application No.: 09/901,472) Examiner: Steven D. Maki
Filed: July 9, 2001) Group Art Unit: 1733
For: Vinyl Film Intermediary)

DECLARATION OF PETER K. KASSAB PURSUANT TO 37 C.F.R. § 1.132

I, Peter K. Kassab, hereby declare as follows:

1. I am the sole inventor of the present application.
2. Just like many other car owners, I have often had to adhere windshield stickers to my car, such as recreational park passes, parking garage stickers, affiliation stickers, event parking stickers, temporary permit stickers, etc. Upon using the stickers, I recognized a problem when attempting to remove the stickers from my vehicle's windshield. The adhesive used was extremely strong, making removal quite difficult and making it virtually impossible to remove and re-use a sticker on a new or different car. Additionally, attempts to remove these stickers with razor blades caused damage to my windshield and defroster strips. Thus, through much experimentation, I developed the present invention to solve problems associated with the use of such stickers and to provide advantages that were not yet available before my invention.
3. I have reviewed the pending office action and prior art cited by the Examiner.
4. I initially developed the first aspect of the invention in the form of a static-cling intermediary layer that is designed to be disposed between a windshield sticker and the vehicle windshield. I later developed another aspect of the invention wherein an intermediary layer included a low-tack adhesive.

5. The first designs of my invention did not include trimming the intermediary layer such as the film layer of the present invention. It was not until I experimented and did extensive testing with different types of film and different types of receiving surfaces that I recognized the benefits of trimming the film. After such experimentation, I then developed a trimming aspect, which is one aspect of my present invention. Trimming the film layer defines peripheral edges of the vinyl film that are in registry with the peripheral edges of the sticker, making the film virtually undetectable and providing many additional benefits. Additionally, in one form of my invention, the protective layer used with the film is also trimmed before its removal from the sticker assembly, which provides benefits such as easier trimming due to the stiffness of the protective layer on the otherwise more floppy film. Additionally, trimming while keeping the protective layer on allows one to carry around or store the prepared sticker assembly without risk of dirt, lint or hand oils getting on the low-tack adhesive before applying it to the glass.

6. I also became aware of "temporary permit stickers" that utilized spaced strips of permanent adhesive. Through additional experimentation, I developed another aspect of the invention that utilizes cutting or trimming strips of the film layer to coincide with the spaced strips of adhesive.

7. I have reviewed the office action and the patents relied upon by the Examiner, including the German '696 patent and the patent to Courtney. As one skilled in the art, the trimming aspect of my invention is not obvious in view of these patents. The German '696 patent makes no mention of trimming, but instead, teaches a "one size fits all" configuration that could be used with most stickers. Courtney is directed to a bumper sticker method and does not even apply to windshield stickers. Thus, as one skilled in the art, I would not be motivated to combine the teachings of these patents. Furthermore, neither German '696 or Courtney refer to the use of strips of vinyl film as claimed in one of the embodiments of my invention. Thus, as one skilled in the art, these patents, as well as the other cited patents, would not teach me how to use strips of vinyl film as in the one embodiment of my invention. Accordingly, as one skilled in the art, I do not find that the German '696 patent and the Courtney patent, as well any of the

other cited patents, render as obvious, the claims of my application that include the trimming element and the strips of film.

8. This conclusion is further supported by my experiences in marketing the product embodying my invention. Over time, I have had an opportunity to witness and otherwise review many uses of my invention. I have often seen users who use my film intermediary with their stickers and who do not trim the vinyl film so that the peripheral edges of the film are essentially in registry with the peripheral edges of the windshield sticker. In these uses, edges of the film extend beyond the edges of the sticker. I have also seen other users remove the protective layer before applying their sticker to the vinyl film, which makes both the application and any attempts to trim the film much more difficult. This occurs notwithstanding the specific instructions I place on the packaging for the product that describe both the protective layer and the trimming step. I have also fielded numerous questions from customers and commercial entities requiring me to often explain the trimming step and its benefits. One such example involved a commercial products catalog company. Despite being experts on describing and creating published layouts for problem solving products, this specific catalog created, published and distributed a national layout showing the use of my product without trimming the film to the peripheral edges of the sticker that it was demonstrated with. Once again, this occurred despite the specific product instructions and the product collateral material that explain the trimming step and its benefits.

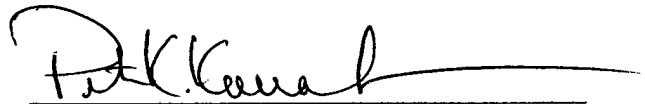
9. Based on my experience from my early developments with the invention along with my skill in the art, seeing how others use my product embodying my invention, and the questions I have fielded from customers, retailers, manufacturers representatives, etc., it is apparent to me that the trimming step is not a generally known aspect.

10. My product has been well-received in the marketplace with sales both nationally and internationally. The favorable acceptance of the invention is further indicated by the fact that sales of my product have continued to increase dramatically year after year. For example, in 2004 to date, over 100,000 units of the product have been sold. This level of sales represents a very successful and wide consumer acceptance of the product, which is believed to be the result of the superiority of the product and its associated methods.

11. Thus, the film intermediary, as is disclosed in this patent application, is considered to have a high degree of commercial success, is widely accepted, and believed to be a welcomed improvement in the industry.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: OCTOBER 20, 2004


Peter K. Kassab

RELATED PROCEEDINGS APPENDIX

There are no related appeals or interferences.